

PATENT

UNITED STATES PATENT AND TRADEMARK OFFICE

In re:	Matthias Gygi	Confirmation No.: 5925
Serial No.:	10/561,748	Examiner: Ren Lu Yan
Filing Date:	April 20, 2006	Group Art Unit: 2854
Docket No.:	1322.1121101	Customer No.: 28075
For:	PRINTING MACHINE	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

CERTIFICATE FOR ELECTRONIC TRANSMISSION:

The undersigned hereby certifies that this paper or papers, as described herein, are being electronically transmitted to the U.S. Patent and Trademark Office on this 13th day of April 2010.

By _____

Kathleen L. Bockley
Kathleen L. Bockley

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this Request.

This Request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets of arguments.

This Request is signed by an attorney or agent of record.

Respectfully submitted,

Matthias Gygi

By his Attorney,

Glenn M. Seager

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Date:

April 13, 2010

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In re:	Matthias Gygi	Confirmation No.:	5925
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PRE-APPEAL CONFERENCE BRIEF

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By Kathleen L. Boekley
Kathleen L. Boekley

Dear Sir:

Appellant has carefully reviewed the Final Office Action dated January 15, 2010 and the Advisory Action dated March 18, 2010. Currently, claims 1-7, 11-16, 21-24 and 26 are pending in the application and have been twice rejected.

Applicant submits that the Examiner's rejections contain at least the following clear errors and/or omissions of one or more essential elements needed for a prima facie rejection.

Claims 1-7, 11-16 and 21-24 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Raksha, U.S. Patent No. 7,047,883, and Corver, U.S. Patent No. 5,247,317. Appellant respectfully appeal sthis rejection. Either the proposed combination of references will not produce the claimed invention or, in the alternative, that motivation is lacking for the combination.

Claim 1, for example, recites "said magnetic element being placed at a location corresponding to said impression on said substrate performed by said screen so as to orientate the pigments contained in the optically variable ink *and create a varying optical effect in said*

impression, and wherein said at least one magnetic element is covered by a sheet of non-magnetic material.” (Emphasis added.) Independent claims 3 and 11 contain similar limitations.

Specifically, it is asserted in the Office Action that “it would also have been obvious...to provide the magnetic elements on the cylinder surface of AAPA, as modified by Raksha et al. with a sheet of non-magnetic material such as aluminum or stainless steel as taught by Carver et al so as to predictably obtain a homogenous magnetic field at the surface of the cylinder.” This cannot be true.

Corver et al. relate to an electrostatic printing device for reproducing information, and more specifically to an electromagnetic printing device (see “Field of the Invention”, column 1, lines 7 to 9). Figure 2 of Corver et al., which is reproduced below, more particularly illustrates a magnified segmented cross-section of the development zone of a printing device according to Corver et al.:

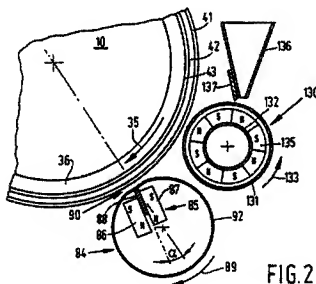


Figure 2 of Corver et al.

Reference numeral 10 designates an image-forming element in the form of a drum 36 rotatable in the direction of arrow 35 and provided with an insulating layer 43 on which are disposed a large number of adjacent and mutually insulated electrodes 42 which extend endlessly in the direction of movement of the drum 36, the electrodes being covered by a dielectric layer 41 (see column 3, lines 23-30).

A magnetic roller 84 is provided next to the rotatable drum 36, which magnetic roller 84 comprises a grounded electrically conductive sleeve 92 rotatable in the direction of arrow 89 about a magnetic system comprising a magnetic knife 85 consisting of a ferromagnetic blade 88 held between two magnets 86 and 87 (see column 3, lines 30-34). The magnets 86, 87 which are in contact with the blade 88 generate a narrow magnetic field in an image-development zone 90 (see column 3, lines 38-41).

A uniform layer of conductive magnetic toner powder is applied to the dielectric layer 41 of the rotatable drum 36 by means of a toner feed device inclusive of a toner reservoir 136 and a magnetic roller 130 which comprises a sleeve 131 of diamagnetic material, such as aluminum, brass or stainless steel. This sleeve 131 is mounted for rotation about a shaft 132 and can be driven into rotation in the direction of arrow 133 by drive means (not shown). A number of magnets 135 are mounted on the shaft 132 of the magnetic roller 130, the shaft being fixed in the frame of the printing device. A homogeneous magnetic field is thus obtained at the surface of the diamagnetic sleeve 131 under the influence of the magnets 135 (see column 3, lines 43-57).

A function of the magnetic roller 130 is thus to apply and transfer a uniform layer of magnetically attractable toner powder onto the circumference of the image-forming element for subsequent development by the downstream-located magnetic roller 84 at the image-development zone 90. A further function of the magnetic roller 130 is that toner powder remaining on the sleeve 92 of the magnetic roller 84 after passing the image-development zone is attracted by the magnetic field of the magnetic roller 130 back to the rotating sleeve 131 (see column 3, line 68 to column 4, line 32).

The function, structure and purpose of the magnetic roller 130 of Corver et al. is thus fundamentally different from what is specifically claimed in the instant application. In particular, a key difference resides in the fact that the magnetic roller 130 is specifically and only used with toner, i.e., printing material that is fundamentally different from printing ink.

In addition, while the magnetic roller 130 of Corver et al. is specifically designed to transfer and apply a uniform layer of printing material (namely toner), the cylinder carrying at least one magnetic element which is a constituent of the claimed invention is not at all designed to apply or transfer any such printing material (namely optically variable printing ink in the context of the claimed invention). The cylinder of the claimed invention is rather used to orient pigments that are contained in the optically variable ink that has been applied onto a substrate by

means of the claimed at least one screen. Claim 1, for example, recites “said magnetic element being placed at a location corresponding to said impression on said substrate performed by said screen so as to orient the pigments contained in the optically variable ink and create a varying optical effect in said impression.”

It is argued in the Office Action that “it would also have been obvious...to provide the magnetic elements on the cylinder surface of AAPA, as modified by Raksha et al. with a sheet of non-magnetic material such as aluminum or stainless steel as taught by Carver et al so as to predictably obtain a homogenous magnetic field at the surface of the cylinder.” If providing the magnetic elements with a sheet of non-magnetic material provides a homogeneous field at the surface of the cylinder, then the machine so produced cannot orient the pigments in the optically variable ink to create a varying optical effect. This is because the varying optical effect in the printed ink is created only by a non-homogeneous magnetic field. If the field is homogeneous then so too is the printed ink, and the claim language of “said magnetic element being placed at a location corresponding to said impression on said substrate performed by said screen so as to orientate the pigments contained in the optically variable ink and create a varying optical effect in said impression” is not met. One cannot create a varying optical effect using a homogeneous magnetic field.

On the other hand, if the addition of a sheet of non-magnetic material does not provide a homogeneous field at the surface of the cylinder as stated by the Examiner, then there is no motivation to make the combination. As the Examiner stated on page 7 of the Office Action, “the Corver et al patent was relied on for the teaching of providing a magnetic roller 130 with a sheet of non-magnetic material 131 such as aluminum or stainless steel to cover the magnets 135 disposed on the surface of the roller for the purpose of obtaining a homogeneous magnetic field at the surface of the cylinder.” This is the sole stated motivation for including Corver in the combination, and without this motivation, Appellant sees no reason why one of skill in the art would modify AAPA in view of Raksha in view of Corver.

In either case, no *prima facie* case of obvious has been made, and Applicant respectfully requests the rejection be withdrawn. Applicant further respectfully submits that independent claims 1, 3 and 11 (and corresponding dependent claims 2, 4-7, 12-16, 21-24 and 26) are patentable over the cited prior art for at least these reasons.

For at least the reasons mentioned above, all of the pending claims are allowable over the cited prior art. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Matthias Gygi

By his attorney,

Date: Apr. 13, 2010



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